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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,011	02/10/2004	Pier Giorgio Vicario	1427-2	9089
23869	7590	11/22/2004	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			SMITH, RICHARD A	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,011

Applicant(s)

VICARIO, PIER GIORGIO

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 10 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "spring device" in claim 4 and "a ring" in claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to because of the following informalities:

Throughout the specification the applicant refers to "at least one screw (8) with adjustment ring nut". The examiner is unclear as to what is an "adjustment ring nut." Is the applicant referring to the knurled enlarged portion of the thumbscrew 8 shown in figures? If so, it would be preferable to call it a thumbscrew since that term is widely recognized. If not, then what is an adjustment ring nut and where is it shown?

Claim Objections

3. Claims 3 and 4 are objected to because of the following informalities:

Claims 3 and 4: In each of these claims "said one or more cursors" lacks antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 1,392,125 to Dudash.

Dudash discloses an adjustable measuring and pointing tool, to be used for construction material measurements in building and metallic carpentry, comprising a bar (1) having an upper plane, a lower part and one or more support feet (7) wherein on said upper plane of said bar a graduated plane (at 2) is realized, which allows the construction material measurement, one or more cursors (3) able to slide along said entire graduated plane of said bar to obtain the construction material desired measures, wherein said one or more cursors comprise at least one screw (6) with adjustment ring nut to allow said one or more cursors locking on said bar.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dudash in view of U.S. 5,915,806 to Levee.

Dudash teaches all that is claimed as discussed in the above rejections of claims 1, 2 and 3 except for said one or more cursors comprise a spring device which prevents said one or more

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cursors to be accidentally released from said bar during use of said adjustable measuring and pointing tool.

Levee discloses a cursor wherein a spring device (spring 54 in combination with a pin 49 at the end of travel, best seen in figure 7) prevents said one or more cursors to be accidentally released from said bar during use of said adjustable measuring and pointing tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the spring device and the pin, as taught by Levee, to the tool, taught by Dudash, in order to provide some tension during movement of the cursor and to prevent said cursor from separating from said bar.

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudash.

With respect to claims 5 and 6, i.e., the bar and the one or more cursors being of aluminum alloy: the Applicant's limitations regarding the bar and cursors being of aluminum alloy are only considered to be the use of "optimum" or "preferred" materials that a person having ordinary skill in the art at the time the invention was made using routine experimentation would have found obvious to provide to make the bar and cursors disclosed by Dudash since they are well known types of materials used to make devices and since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention, In re Leshen, 125 USPQ 416. In this case, because aluminum alloy is widely available, fairly strong and relative cheap to acquire and form.

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9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dudash in view of U.S. 5,937,531 to Menk et al.

Dudash teaches all that is claimed as discussed in the above rejections of claims 1, 2 and 3 except for the lower part being provided with a reinforcement core with rhomboidal structure made of aluminum alloy.

Menk et al. discloses a couple of embodiments wherein one design is a simple bar shape (figures 1-4), one is an I beam shape (figures 5-8) and one is an I beam type shape employing a truss, i.e., reinforcement core, (figures 9 and 14) in order to obtain an elongated body with increased stability and rigidity (column 10, lines 7-10) and discloses that the device can be made from plastic or other material. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the bar, taught by Dudash, to include a larger cross section and a reinforcement core, as taught by Menk et al., in order to provide an elongated body having increased stability and rigidity and that will be less likely to be bend or break.

With respect to the reinforcement core having a rhomboidal structure, as claimed: This structure is only considered to be an obvious modification of a truss or reinforcement core taught by Menk et al., because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976).

With respect to the reinforcement core being of aluminum alloy: the Applicant's limitations regarding the core being of aluminum alloy are only considered to be the use of "optimum" or "preferred" materials that a person having ordinary skill in the art at the time the

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invention was made using routine experimentation would have found obvious to provide to make the core disclosed by Dudash as modified by Menk et al., since they are well known types of materials used to make devices and since it has been held to be a matter of obvious design choice and within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use of the invention, In re Leshen, 125 USPQ 416. In this case, because aluminum alloy is widely available, fairly strong and relative cheap to acquire and form.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dudash in view of U.S. 1,262,678 to Lapoint.

Dudash teaches all that is claimed as discussed in the above rejections of claims 1, 2 and 3 except for the tool comprises a ring.

Lapoint disclose a tool wherein the tool comprises a ring in order to allow an easier grip. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the tool, taught by Dudash, by adding a ring, as suggested by Lapoint, in order to assist the user in handling the tool.

With respect "to hang up" the tool: this intended use has not been given any patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related tools.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



R. Alexander Smith
Patent Examiner
Technology Center 2800

RAS
November 16, 2004